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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200832
Party	Defendant Honda Giken Kogyo Kabushiki Kaisha (Honda Motor Co., Ltd.)
Correspondence Address	MICHAEL J BEVILACQUA WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE ST BOSTON, MA 02109-1800 UNITED STATES silena.paik@wilmerhale.com, michael.bevilacqua@wilmerhale.com, john.regan@wilmerhale.com, sarah.frazier@wilmerhale.com
Submission	Reply in Support of Motion
Filer's Name	Sarah Frazier
Filer's e-mail	Sarah.Frazier@wilmerhale.com
Signature	/SARAH R. FRAZIER/
Date	10/01/2012
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD

BRIGGS & STRATTON CORPORATION	)	
and KOHLER CO.,	)	
	)	
Opposers,	)	
	)	Opposition No. 91200832 (parent)
v.	)	
	)	Opposition No. 91200146
HONDA GIKEN KOGYO KABUSHIKI	)	
KAISHA,	)	Application Serial No. 78924545
	)	
Applicant.	)	
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	)	
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**APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA’S REPLY IN SUPPORT  
OF ITS MOTION TO COMPEL PRODUCTION OF DOCUMENTS FROM OPPOSERS  
BRIGGS & STRATTON CORPORATION AND KOHLER CO.**

## I. INTRODUCTION

Applicant Honda Giken Kogyo Kabushiki Kaisha (“Honda”) is aware that the Board disfavors reply briefs that rehash previously-made arguments. Honda will refrain from doing so here. However, there are certain allegations in Opposers’ Joint Brief in Opposition to Applicant’s Motion to Compel Production of Documents from Opposers (“Opposers’ Brief”) that require a response.

Discovery is appropriate where the subject matter of the request “is relevant to the claim *or defense* of any party.” Fed. R. Civ. P. 26(b) (emphasis added). Opposers’ Brief, with its extreme allegations and broad, generic objections, tries to mask the fact that Honda is entitled to the documents sought in its Motion to Compel Production of Documents (“Honda’s Motion”) because they are relevant to Honda’s *defenses*. What Opposers do not hide is their willingness to only produce “documents *supporting* Opposers’ claims” or that “*they* intend to rely on.” Opposer’ Brief at 9 and 16 (emphasis added). Consequently, Opposers believe Honda’s requests must be “narrowly tailored to the issue [sic] of *lack* of secondary meaning and functionality.” *Id.* at 10 (emphasis added).

Opposers’ clear refusal to produce *their* documents that show the *existence* of secondary meaning and *non*-functionality is unjustified. Their treatment of the discovery process as a one-way street (namely one that only supports Opposers’ claims), in addition to the grounds laid out in Honda’s Motion, warrants an order compelling the production of documents as requested by Honda.

## II. ARGUMENT

Honda extensively engaged with Opposers regarding its discovery requests before filing its Motion. Allegations that Honda’s efforts were not made in good faith are false and belied by

the record. Honda has made every reasonable effort to compromise and tailor its requests in response to Opposers' objections. Consistent with their past attempts to frustrate the discovery process, Opposers' Brief continues to quote from and respond to Honda's original requests and ignore the numerous concessions Honda has made in an effort to reach agreement and avoid burdening the Board with a discovery dispute.

The specifics of Honda's requests, and its explanations as to their relevance, are detailed in Honda's Motion and will not be repeated here. Rather than substantively rebut Honda's relevancy arguments, Opposers attempt to distract the Board with false accusations about ulterior motives and make sweeping objections that Honda's requests are overly broad and unduly burdensome. But in light of the facts and Opposers' own statements, these broad and unsubstantiated assertions are not sufficient to relieve Opposers' of their discovery obligations. Honda's Motion should therefore be granted.

**A. Honda Engaged in an Extensive, Good Faith Effort to Resolve Discovery Disputes Before Filing its Motion to Compel**

Honda's motion meets the requirements of TBMP § 523.02 in both form and spirit. At the time of filing, counsel for Honda certified that a good faith effort had been made through conference and correspondence to reach agreement with Opposers. *See* TBMP § 523.02 (citing 37 C.F.R. § 2.120(e)). The record set forth in Honda's Motion evidences these good faith efforts, including numerous emails, letters and a lengthy telephonic meet and confer.

Honda disagrees with Opposers' claim that Honda's Motion was the first time it limited its requests to the Briggs 550 Series and the Kohler SH265 engines. But engaging in a he-said-she-said debate is unnecessary to assess the merits of Honda's Motion. The numerous cited communications with the Opposers make clear, as does their Brief, that they are unwilling to

produce documents *regardless* of the compromises set forth by Honda. The record set forth in Honda's Motion, and counsel's certification, are more than sufficient to demonstrate Honda's good faith effort in resolving these discovery issues and Honda's good grounds for its motion.

**B. Allegations that Honda's Document Requests are a "Fishing Expedition" for Other Proceedings are Unfounded, Untrue, and Rendered Moot by the Protective Order**

Honda's Motion should be considered for what it is—a standard request to obtain documents in Opposers' possession that are relevant to the issues in this TTAB proceeding. Opposers initiated this action. To believe the conspiracy theories set forth in Opposers' Brief would be to accept that this "fishing expedition" was started by the fish—since it is Honda who is the target in this proceeding.

Opposers' allegations that Honda's Motion is designed to unearth information for hypothetical future litigations or a foreign proceeding have no basis in reality. Rather than respond to Honda's explanations regarding the relevance of the sought documents in *this* proceeding, Opposers are trying to distract the Board with groundless accusations about other proceedings. Moreover, the legal foundation for these arguments is lacking. Opposers offer no substantive citations for their claims that discovery is unavailable in Italian proceedings, or that discovery has not been ordered in the particular case referenced.<sup>1</sup> Opposers' Brief at 4 and 11, Herring Decl. at ¶ 6.

Any legitimate concerns over the use of discovery can be resolved by Opposers designating materials as "Attorneys' Eyes Only," as provided for under the Protective Order, which would limit disclosure of Opposers' documents to Honda's outside counsel in this matter.

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<sup>1</sup> Opposing counsel's declaration regarding his "belief" about Italian law is improper and insufficient support for the claim that discovery is unavailable in the Italian proceeding. Herring Decl. at ¶ 6. Counsel is not a witness in these proceedings. Nor has he made any showing that he is an expert on the Italian legal system.

Dkt. 8 at 4. If Opposers require further assurances as to the scope of use of discovery materials, the parties can confer and agree on appropriate measures to alleviate those concerns.

**C. Opposers' Generic Objections Regarding Overbreadth and Undue Burden are Premised on Erroneous Assumptions**

Opposers' arguments that Honda's requests are overly broad because these requests may capture documents relevant to both issues in this proceeding and other issues (namely infringement), and that Opposers' Knock-Off Products are only relevant to issues that *support* Opposers' claims, are without merit. Since copying is a factor to be considered in assessing secondary meaning, the issues of infringement and secondary meaning are inextricably intertwined. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1379 (Fed. Cir. 2012). That Honda's requests may capture some documents related to infringement does not necessarily make those requests overly broad. That objection is insufficient to justify the non-production of such documents. Honda's Motion also makes clear the numerous ways in which documents associated with Opposers' Knock-Off Products are relevant to Honda's defenses, a point which Opposers failed to address in their Brief.

Opposers attempt to circumvent the discovery process by seeking to hide behind the "we're big companies" shield, citing terabytes of data, different locations, and the number of their employees as justifications for their objections. However, the sincerity of Opposers' argument as to the burden associated with producing responsive documents is highly questionable given their concession that they have produced "documents supporting Opposers claims" that "they intend to rely on" (Opposers' Brief at 9 and 16), and affirmative statements regarding the existence, or rather the lack thereof, of documents relevant to copying the proposed

GX Engine trademark. Opposers' Brief at 14 and 16. How can Opposers, absent a review, insist there are no responsive documents?

Opposers' assertions that there are no documents relevant to their copying of the proposed GX Engine trademark are also questionable in light of the progression shown below. That Briggs could move from its more traditional engine design (left) to the 550 Series (middle) without considering Honda's mark (right) is dubious.



Opposers also assert that responding to Honda's document requests would require interviewing and searching through the files of thousands of employees. At the same time they complain that they are "hampered by the fact that the lead marketing and engineering employees for the SH265 project are no longer with Kohler." Opposers' Brief at n. 3. It is curious that Opposers were easily able to identify the individuals most likely to have relevant information to support Opposers' claims and their justifications to not produce documents. If Opposers can identify and locate all the documents supporting their claims (a one-way process which is

insufficient to meet their discovery obligations),<sup>2</sup> they should be ordered to locate documents that may support Honda's claims.

Furthermore, Opposers have made *no* effort to compromise or to identify reasonable alternatives to the full-fledged searches that they argue are required to identify the categories of documents Honda is seeking. Allowing these generic arguments of overbreadth and undue burden to succeed would encourage companies to file Oppositions against competitors and to burden them with discovery costs while incurring minimal expenses of their own.

#### **D. Opposers' New Objections Do Not Defeat Honda's Relevancy Arguments**

In addition to the broad objections about scope and burden, Opposers' Brief raised a series of new objections. None of these objections have merit.

Opposers suggest they should not have to produce documents regarding their purchase of Honda GX engines because "Honda and its dealers undoubtedly have their own records of engine sales." Opposers' Brief at 13. This argument is unavailing. These engines could have been purchased at numerous stores and retailers, many of which are not within the control of Honda. Furthermore, Opposers' argument that "it would be very difficult and time consuming, if not impossible, to separate these purchases by their purpose" defies common sense—Opposers

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<sup>2</sup> Opposers' characterizations of Honda's document production is informative in assessing the sufficiency of Opposers' own productions. After dismissing Honda's production of tens of thousands of pages as consisting "of documents produced and pleadings filed in prior federal court cases," Opposers go on to state that "as to new issues that have arisen since those cases, Honda has produced *essentially nothing*." Opposers' Brief at n. 2 (emphasis added).

These tens of thousands of pages of documents were produced in response to Opposers' explicit request for "[a]ll documents relating to any legal proceedings wherein APPLICANT attempted to enforce the ENGINE CONFIGURATION as a trademark or trade dress against third parties anywhere in the world, or where any third party challenged the validity of the ENGINE CONFIGURATION as a trademark or trade dress, including but not limited to all pleadings, depositions, expert reports, written discovery requests and responses, document productions and settlement agreements therein." Exhibit C to Honda's Motion (Opposers Briggs & Stratton Corporation's First Set of Requests for Production of Documents to Applicant) at No. 4.

Because Honda's trade dress was established in those proceedings, these documents encompassed much of the universe of documents relevant to this Opposition. However, in addition to these materials, Honda has produced more than 3,000 pages—*ten times* the size of Opposers' combined productions. Declaration of Colleen Dow at ¶ 3.



were apparently able to confirm there are no documents evidencing that these purchases were made to copy the GX Engine trademark. *Id.*

Another new argument is that Honda's request for documents regarding "differences and similarities" between Opposers' Knock-Off Products and the GX Engines are vague and ambiguous. But the differences and similarities referenced are those that Opposers themselves have raised repeatedly since this proceeding began. *See, e.g.*, Dkt. 1 at ¶ 8. Opposers claim that they now find these terms unclear is disingenuous.

Opposers also argue that Honda's request for correspondence between Briggs and its advertising agencies referring or relating to the GX Engine trademark was raised for the first time in Honda's Motion. The record makes clear that this is incorrect. As reflected in the letter memorializing the parties' meet and confer, it was Honda's understanding that the parties had reached an agreement regarding this request. *See* Ex. Z to Honda's Motion at 8 ("RFP No. 36:... Briggs agreed to follow-up on whether it has any responsive documents in its possession, custody or control and to produce any such documents."). However, in a later correspondence, Briggs stated that it "has no documents in its possession *that it agreed to produce.*" Ex. CC to Honda's Motion at 4 (emphasis added).

It is clear from Opposers' Brief that it only agreed to "produce responsive nonprivileged communications between [Briggs] and its advertising agencies, if any, *regarding Applicant's claim that is alleged mark has acquired distinctiveness and is not functional.*" *See* Ex. G to Honda's Motion at No. 36; Opposers' Brief at 20. Once again, Opposers unilaterally decided to narrow this request to exclude many documents relevant to this proceeding, including communications that may mention a desire to emphasize in advertising the elements of Briggs'

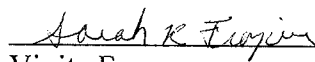
Since Opposers offer no valid justification for withholding these documents, they should be produced.

### III. CONCLUSION

For the reasons set forth above and in Honda's Motion, Honda respectfully requests that the Board grant its Motion to Compel the Production of Documents from Opposers.

HONDA GIKEN KOGYO KABUSHIKI KAISHA  
(HONDA MOTOR CO., LTD.)

By its attorneys,

  
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Vinita Ferrera  
John Regan  
Silena Paik  
Sarah Frazier  
Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, Massachusetts 02109  
(617) 526-6000

Date: October 1, 2012

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BRIGGS & STRATTON CORPORATION	)	
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HONDA GIKEN KOGYO KABUSHIKI	)	
KAISHA,	)	Application Serial No. 78924545
	)	
Applicant.	)	
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**DECLARATION OF COLLEEN DOW IN SUPPORT OF APPLICANT HONDA GIKEN  
KOGYO KABUSHIKI KAISHA’S REPLY IN SUPPORT OF ITS MOTION TO  
COMPEL PRODUCTION OF DOCUMENTS FROM OPPOSERS BRIGGS &  
STRATTON CORPORATION AND KOHLER CO.**

I, Colleen Dow, pursuant to 28 U.S.C. § 1746, declare as follows:

1. I am a paralegal at the law firm of Wilmer Cutler Pickering Hale and Dorr, counsel for Honda Giken Kogyo Kabushiki Kaisha (“Honda”), the Applicant in the above-entitled proceedings.
  
2. Honda made its first document production on January 9, 2012 and has continued to produce documents on a rolling basis, totaling nearly 100,000 pages to date.
  
3. Honda has produced over 3,000 pages of documents that do not relate other legal proceedings regarding the GX Engine trademark.

I declare under the penalty of perjury that the foregoing is true and correct.

Date: October 1, 2012

  
Colleen Dow

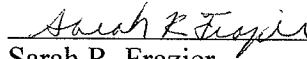
CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Applicant Honda Giken Kogyo Kabushiki Kaisha's Reply in Support of Its Motion to Compel Production of Documents From Opposers Briggs & Stratton Corporation and Kohler Co. was served by first class mail, postage prepaid, this 1<sup>st</sup> day of October, 2012 upon:

Donald Daugherty  
Whyte Hirschboeck Dudek S.C.  
555 E. Wells Street, Suite 1900  
Milwaukee, Wisconsin 53202

And

Robert N. Phillips  
Seth B. Herring  
Reed Smith LLP  
101 Second Street  
Suite 1800  
San Francisco, California 94105

  
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Sarah R. Frazier